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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,842	04/14/2004	Michael C. Van Zandt	03-272-A	5466

20306 7590 03/02/2007  
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER
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RAHMANI, NILOOFAR

ART UNIT	PAPER NUMBER
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1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/823,842

Applicant(s)

VAN ZANDT ET AL.

Examiner

Niloofer Rahmani

Art Unit

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 and 16-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-15 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

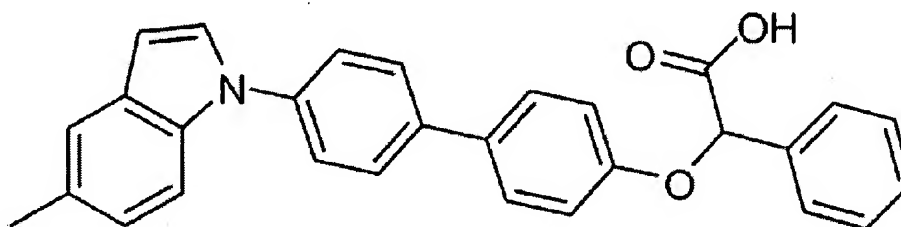
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|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-30 are pending in the instant application.

Applicant's election of group II in the reply filed on 01/22/2007 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The elected species has the following structure:



wherein L being O and A-ring being aryl.

Claims 1-9(in part), 13-15(in part), and 30(in part), which are drawn to group II are examined. Claims 10-12, 16-29, and 30(in part) remaining subject matter being drawn to the non-elected invention are withdrawn per 37 CFR 1.142(b).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**2. Priority**

This application is filed on 04/14/2004, which claims benefit of 60/467,057, filed on 04/30/2003.

**3. Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

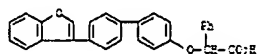
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Murthy et al., Bioorganic & Medicinal Chemistry, Vol. 10,2002, pages 2267-2282. Murthy et al. disclosed the instant claimed compounds on page 2269, Table 1. compounds 6-28, 32-48, 58, 62, page 2273, Table 2., compounds 1-16. Therefore, the instant claim is anticipated by Murthy et al.

4. Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Malamas et al., US 6,232,322. Malamas et al. disclosed the instant claimed compounds, which from the STN search are

**RN** 250341-86-7

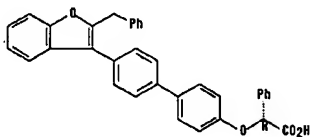
**CN** Benzeneacetic acid, a-[[4'-(3-benzofuranyl)[1,1'-biphenyl]-4-yl]oxy]-



**RN** 250341-99-2

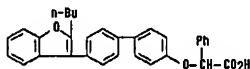
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**CN** Benzeneacetic acid, a-[[4'-[2-(phenylmethyl)-3-benzofuranyl][1,1'-biphenyl]-4-yl]oxy]-, (aR)-



**RN** 250342-02-0

**CN** Benzeneacetic acid, a-[[4'-(2-butyl-3-benzofuranyl)[1,1'-biphenyl]-4-yl]oxy]-



. Therefore,

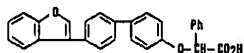
the instant claim is anticipated by Malamas et al.

5. Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Malamas et al., J. Med. Chem., 2000, Vol. 43, pages 1293-1310. Malamas et al. disclosed the instant claimed compounds on page 1298, compounds 62-97, and page 1300, compounds 103-135. Therefore, the instant claim is anticipated by Malamas et al.

6. Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Malamas et al., WO 9958518. Malamas et al. disclosed the instant claimed compounds, which from the STN search are

**RN** 250341-86-7

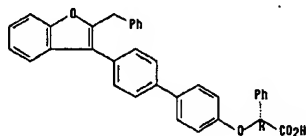
**CN** Benzeneacetic acid, a-[[4'-(3-benzofuranyl)[1,1'-biphenyl]-4-yl]oxy]-



**RN** 250341-99-2

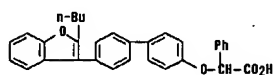
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**CN** Benzeneacetic acid, a-[[4'-[2-(phenylmethyl)-3-benzofuranyl][1,1'-biphenyl]-4-yl]oxy]-, (aR)-



**RN** 250342-02-0

**CN** Benzeneacetic acid, a-[[4'-(2-butyl-3-benzofuranyl)[1,1'-biphenyl]-4-yl]oxy]-

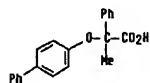


Therefore, the instant claim is anticipated by Malamas et al.

7. Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Schacht et al., US 4072754. Schacht et al. disclosed the instant claimed compounds, which from the STN search are

**RN** 56855-38-0

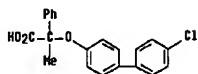
**CN** Benzeneacetic acid, a-([1,1'-biphenyl]-4-yloxy)-a-methyl-



**RN** 56855-39-1

**CN** Benzeneacetic acid, a-(4'-chloro[1,1'-biphenyl]-4-yloxy)-a-methyl-

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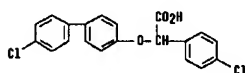


Therefore, the instant claim is anticipated by Schacht et al.

8. Claims 1-9, 13-15, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolhofer et al., DE 2307038. Bolhofer et al. disclosed the instant claimed compounds, which from the STN search are

**RN** 50819-85-7

**CN** Benzeneacetic acid, 4-chloro-a-[(4'-chloro[1,1'-biphenyl]-4-yl)oxy]-



Therefore, the instant claim is anticipated by Bolhofer et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Mckenzie, can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

02/26 /2007

NV

A handwritten signature in black ink, appearing to read "Thomas McKenzie", is written over the printed name.

THOMAS MCKENZIE

SPE

GROUP 1625